

REMARKS

The present response simplifies issues for appeal and raises no new issues that would require further search or consideration, so entry of the present response is proper. Applicants respectfully request reconsideration of the application in light of the following remarks.

1. Status of the Claims

The status of the claims following entry of the amendment is as follows:

Claims canceled: Claims 1-2 and 7-28

Claims pending: Claims 3-6 and 29-33

Claims allowed: None

Claims rejected: Claims 3-6 and 29-33

Claims withdrawn: None

2. Request for Consideration of Information Disclosure Statements (IDSs)

Applicants note with appreciation the consideration and acknowledgement of the IDS filed July 15, 2008. Applicants request that the IDSs filed August 26, 2008, and December 8, 2008, be considered and acknowledged with the Office's next communication.

3. Notice of Prosecution in Related Applications

The Office alleges that Applications No. 10/485,456 and No. 10/529,014 are related to the present application. The following Office Actions were issued by Examiner Pagonakis in Application No. 10/485,456:

- Requirement for Restriction/Election, mailed June 24, 2008; and
- Non-Final Rejection, mailed December 9, 2008.

The following Office Actions were issued by Examiner Westerberg in Application No. 10/529,014:

- Requirement for Restriction/Election, mailed March 27, 2008;
- Non-Final Rejection, mailed July 3, 2008; and

- Final Rejection, mailed March 2, 2009.

4. Status of the Figures

In the Office Action dated January 16, 2008, the Office objected to the Figures. Office Action, ¶ bridging pages 3-4. Applicants traversed the objection in their response filed July 15, 2008. The present Office Action Summary does not repeat the objection but does not indicate whether the Drawings are accepted.

Applicants thus respectfully request an indication that the Drawings are accepted.

5. Status of the Specification

In the Office Action dated January 16, 2008, the Office objected to the specification's Abstract. Applicants provided a substitute Abstract addressing the Office's concerns. Applicants respectfully request acknowledgement that the Abstract has been accepted.

6. Response to Applicants' Arguments

Applicants appreciate the withdrawal of the rejections of record in response to Applicants' Response and Amendment filed July 15, 2008.

7. Rejection under 35 U.S.C. § 102(e)

Claims 4 and 29 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Published Application No. 2004/0266874 A1 ("Akimoto"). The Office rejects claims 4 and 29 as allegedly anticipated by Akimoto, because the Office gives no patentable weight to the "intended use of the composition" administered in claim 29 and dependent claim 4. Office Action, p. 3, item 10.

Applicants traverse. The Office must give patentable weight to the claim feature "a drop of elasticity of blood vessels associated with aging" in an individual. Terms in a preamble are given patentable weight, where the preamble provides antecedent basis for a term in the body of the claim. See *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 480 (C.C.P.A. 1951). In the present case, the recited composition is administered to "*the* individual." Claim 29, line 2

(emphasis added). Antecedent basis for the individual is provided in the preamble of claim 29, which recites: “A method of treating a drop of the elasticity of blood vessels associated with aging *in an* individual” (emphasis added). The preamble states that the individual has within him / her a drop of the elasticity of blood vessels associated with aging.

Anticipation only can be established where a single prior art reference teaches each and every element of the claimed invention, either explicitly or inherently. *Verdegaal Bros. v. Union Oil Co. Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “Inherency, however, may not be established by probabilities or possibilities.” *In re Oelrich*, 666 F.2d 578, 581-82 (C.C.P.A. 1981); *see also Ex parte Whalen*, 89 U.S.P.Q.2d 1078, 1083 (Bd. Pat. App. & Int. 2008) (“[E]ven if some of the compositions encompassed by Evans’ broad disclosure might have [the recited] viscosity . . . , that possibility is not adequate to support a finding of inherent anticipation.”) (precedential).

Akimoto discloses, among other things, a method of treating or ameliorating symptoms or diseases caused by decreased brain function in a subject comprising administering to the subject a composition containing arachidonic acid and/or a compound having arachidonic acid as a constituent fatty acid. That is, the “subject” disclosed in Akimoto has symptoms or diseases caused by decreased brain function. In the present case, however, the individual to whom the recited composition is administered has a drop of the elasticity of blood vessels associated with aging. An individual with symptoms or diseases caused by decreased brain function will not *necessarily* have a drop of the elasticity of blood vessels associated with aging, nor will the latter individual *necessarily* have symptoms or diseases caused by decreased brain function. The compositions accordingly are administered to individuals in populations that possibly—but do not necessarily—overlap. A *prima facie* case of anticipation based on inherency, however, *cannot* be established on the basis of mere possibility. *See Oelrich*, 666 F.2d at 581-82; *Whalen*, 89 U.S.P.Q.2d at 1083.

Indeed, Akimoto discloses a *direct* action of arachidonic acid on the brain, resulting in improvement of brain function. *See, e.g.*, Akimoto, col. 3, ¶ 18. Akimoto, however, does not describe or suggest that arachidonic acid treats a drop of the elasticity of blood vessels. On the

other hand, according to the present invention, arachidonic acid treats a drop of the elasticity of blood vessels associated with aging, which alleviates at least arteriosclerotic dementia. Thus, the mechanism of action of the present invention and of Akimoto differ.

For all the reasons above, the Office has not established *prima facie* anticipation, and the rejection should be withdrawn and the claims allowed.

6. Rejection under 35 U.S.C. § 103(a)

Claims 3-6 and 29-32 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Akimoto in view of Strub, *Southern Med. J.* 96: 363-66 (“Strub”); and Nucleus Medical at <http://ebSCO.smartimagebase.com/displaymonograph.php?MID=138> (“Nucleus Medical”).

Applicants traverse the rejection, because Akimoto is unavailable as prior art. 35 U.S.C. § 103(c) provides, *inter alia*:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In the present case, Akimoto may qualify as art under 35 U.S.C. § 102(e)(1). However, both Akimoto and the present application are assigned to Suntory Ltd. See EX. 1 and EX. 2, attached below. 35 U.S.C. § 103(c) disqualifies Akimoto as prior art, because [1] the rejection is under 35 U.S.C. § 103, not under § 102; [2] Akimoto is available as prior art under 35 U.S.C. § 102(e)(1); and [3] Akimoto and the present application are commonly owned.

The rejection is based on Akimoto as the primary reference in the proposed combination of Akimoto, Strub, and Nucleus Medical. The Office does not make a case that the rejection can stand on Strub and Nucleus Medical alone. Because the Office has not made a *prima facie* case of obviousness over the combination of only Strub and Nucleus Medical, the rejection is improper and should be withdrawn. Applicants request allowance of the claims.

CONCLUSION

The application is believed to be in condition for allowance, and an indication of the same is respectfully requested. Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 50-0573 for any such fees; and Applicants hereby petition for any needed extension of time. If an Appeal Fee is required to maintain pendency of the present application, the Office is authorized to charge the Appeal Fee and use this paper as a Notice of Appeal.

Respectfully submitted,

Date: May 26, 2009

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Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

Exhibit 1

Copy of the Patent Assignment Abstract of Title for Akimoto



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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10485456

Filing Dt: 08/10/2004

Publication #: 20040266874

Pub Dt: 12/30/2004

Inventors: Kengo Akimoto, Hiroshi Kawashima, Yoshiko Ono, Hiroshige Okaichi, Youko Okaichi

Title: Composition having effects of preventing or ameliorating conditions or diseases caused by brain hypofunction

Assignment: 1

Reel/Frame: 015666/0204

Recorded: 08/10/2004

Pages: 2

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 02/02/2004

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Exec Dt: 02/02/2004

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Attorney Docket No.: 47237-0561-00-US (216942)

Application No.: 10/541,073

Office Action Dated: November 26, 2008

Reply Dated: May 26, 2009

Exhibit 2

Copy of the Patent Assignment Abstract of Title for the present published application



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Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10541073

Filing Dt: 06/29/2005

Publication #: 20060088573

Pub Dt: 04/27/2006

Inventors: Yoshiyuki Ishikura, Chika Horikawa, Yoshiko Ono, Kengo Akimoto, Yasuo Matsumura

Title: Composition having action preventing or alleviating symptoms or diseases due to aging of blood vessels

Assignment: 1

Reel/Frame: 017409/0690

Recorded: 06/29/2005

Pages: 2

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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